

Inventors: Klein et al.
Serial No.: 09/814,604
Filed: March 22, 2001
Page 2

SRC-1/NCoA-1,
TIF-2/GRIP-1/NCoA-2,
ACTR/p/CIP/AIB1/NCoA-3,
p300/CBP,
p/CAF, and
TATA box binding protein.

Election of Invention

Applicants respectfully traverse the Election of Species requirements for the reasons stated below. Nevertheless, in order to be responsive to the Office Action, Applicants provisionally elect the retinoic acid receptor (RAR) as the species of nuclear hormone receptor and further provisionally elect TIF-2/GRIP-1/NCoA-2 as the species of co-activator. The claims which read, at least in part, upon the elected RAR and GRIP-1 species are claims 1 to 14 and 16 to 26.

Traversal

Applicants respectfully point out that two separate requirements must be met in order for restriction to be proper. First, the inventions must be independent or distinct. Secondly, there must be a serious burden on the Examiner if restriction is required. See, for example, MPEP 803 (Restriction- When Proper), which states, in part:

If the search and examination of an entire application can be made without serious

Inventors: Klein et al.
Serial No.: 09/814,604
Filed: March 22, 2001
Page 3

burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Page 800-3; emphasis added.

Similarly, if the members of a Markush group are relatively few or so closely related that a search and examination of the entire claims can be made without serious burden, "the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions (MPEP, page 800-4, second column, first paragraph; emphasis added). Thus, it is not sufficient for an Examiner to assert that patentably distinct inventions are present in order to require an election of species. There also must be a serious burden on the Examiner to search and examine the entire application.

In the present case, given the small number of recited hormone receptors and co-activators, and the fact that there would be significant overlap in searching each of the five recited nuclear hormone receptors and each of the six recited co-activators, Applicants submit that the Examiner would not be seriously burdened to search and examine the claims in their entirety. Thus, although the various recited nuclear hormone receptors and various co-activators are patentably distinct, it is not appropriate for the Examiner to require the election of a single nuclear hormone receptor or single co-activator. Applicants respectfully request that the Examiner reconsider the Election of Species requirements.

Inventors: Klein et al.
Serial No.: 09/814,604
Filed: March 22, 2001
Page 4

In the event that the Election of Species requirements are maintained, Applicants respectfully remind the Examiner that subject matter directed to non-elected species previously withdrawn from consideration must be rejoined and examined for patentability if a linking claim such as generic claim 1 is found allowable (MPEP 809).

II. CONCLUSION

In sum, Applicants provisionally elect the retinoic acid receptor and further provisionally elect the co-activator TIF-2/GRIP-1/NCoA-2. Applicants further request that the Examiner reconsider the Election of Species requirements and examine all nuclear hormone receptor species and all co-activators together.

The Examiner is invited to call the undersigned agent or Cathryn Campbell if there are any questions regarding this application.

Respectfully submitted,

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Date

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